

REMARKS

Re-examination and favorable reconsideration in light of the above amendments and the following comments are respectfully requested.

Claims 18 - 34 are pending in the application. Currently, claims 18 - 28 stand withdrawn from consideration and Claims 29-34 stand rejected.

By the present amendment, Applicant has amended claim 29 and cancelled withdrawn claims 18 - 28 without prejudice. Applicant reserves the right to file a divisional application to said claims 18 - 28.

In the office action mailed August 5, 2010, the Examiner objected to the drawings and the specification. Appropriate amendments have been made to the drawings and the specification. Applicant respectfully requests that this objection be withdrawn.

Claim Rejections Under 35 USC §112, First Paragraph.

Claims 29-34 stand rejected to under 35 USC §112, first paragraph as being based on a disclosure which is purported to be non-enabling. The Examiner contends that an element critical or essential to the practice of the invention, but not include in the claim(s) is not enabled by the disclosure. The Examiner notes that the claims are drawn to a method of providing a core in which a channel receives a high tension wire of the engine or machine. While it is understood, that the high tension wire is used to provide electricity to generate a spark for burning fuel in the engine or motion, the Examiner contends that it is not understood what the purpose is of providing the core. The Examiner contends that there is no relationship explained

between the wire, the core, and what advantage, benefit or action the two are providing in terms of the actual functioning of the engine or machine. Applicant respectfully requests that this rejection be withdrawn.

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the application. See MPEP 2164. Any analysis of whether a particular claim is supported by the disclosure requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement is whether the experimentation needed to practice the invention is undue or unreasonable. See MPEP 2164.01; also see *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). It is also well settled that a patent application need not teach, and preferably omits, what is well known in the art. See *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991).

The burden on the Examiner in making a rejection on enablement grounds is set out in MPEP 2164.04. It requires the Examiner to construe the claims prior to commencing an enablement analysis. In order to make a rejection, the Examiner has to establish a reasonable basis to question the enablement provided for the claimed invention and establish that undue experimentation is required. The Examiner besides identifying any missing information must explain why one skilled in the art could not supply the information without undue experimentation. See MPEP 2164.04 and 2164.06(a).

The rejection is deficient because the Examiner has not conducted the required claim construction *ab initio* and does not even mention that undue experimentation would be required to enable the claimed invention. Further, the Examiner has not applied any of the *Wands* factors as required by the MPEP. Still further, while the Examiner has contended that the purpose of the core is not understood, no explanation has been provided as to why one skilled in the art could not determine that purpose without undue experimentation. In conclusion, the Examiner has not met her burden of establishing a proper enablement rejection, it should be withdrawn.

By the present amendment, claim 29 has been amended to specify that the electromagnetic field which is generated in the core "radiates from the fore to act on a fuel in the engine or machine." This amendment is supported by page 10, lines 15 - 17 of the specification. Claim 29 now specifies the relationship between the high tension lead, the core and the interaction between the core and the fuel in the engine or machine. The subject matter essential to the invention is included in amended claim 29. Further, the invention defined by claim 29 can be practiced without any undue experimentation. 35 U.S.C. 112, first paragraph requires nothing more.

It should be further recognized that the skilled person is familiar with fuel burning engine or machines and their operation using high tension leads. It is clear from the specification in the instant application that the level of ordinary skill in the art extends to methods involving the operation of fuel burning engines or machines which incorporate high tension leads.

The relationship between the high tension lead, the core and the advantage, benefit and action that the two provide on

the function of the engine or machine is described on page 10, line 11 to page 11, line 21 of the specification. The nature of this invention is clear from this portion of the specification.

Pages 10, lines 1 - 10 and figure 5 provide a working example of the method in which a high tension cable is positioned within a core and electricity is applied to the high tension cable. The third paragraph on page 10 describes the interaction between the electricity, the high tension cable, the core and the fuel in the engine or machine. The application therefore provides a working example which would enable a skilled person to make, use, and perform the claimed invention.

Since the specification provides sufficient direction to enable a skilled person to perform the claimed invention , such a person would not have to exercise any experimentation in order to perform the claimed method. The skilled person would merely follow the claimed method, taking into account the direction provided on page 10 onwards in the specification. No undue experimentation is required.

For these reasons, the rejection should be withdrawn and claims 29 - 34 should be allowed. Such allowance is respectfully solicited.

The instant amendment after final rejection should be entered since it places the case in condition for allowance and adds nothing to the claims which the Examiner could not have ascertained by a reading of the specification. Further, the amendment does not require the Examiner to conduct any new search or raise any issue which requires further consideration by the Examiner. Still further, the amendment does not raise any issue of new matter since the amendment is well supported by the originally filed specification.

Should the Examiner believe an additional amendment is

needed to place the case in condition for allowance, the Examiner is hereby invited to contact Applicant's attorney at the telephone number listed below.

No fee is believed to be due as a result of this response. Should the Director determine that a fee is due, he is hereby authorized to charge said fee to said Deposit Account No. 02-0184..

Respectfully submitted,

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